



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,054	01/15/2002	Etienne Georges Maze	003744-02	2937

7590 07/12/2004
Brenda L. Havel
Metal Coatings International Inc.
275 Industrial Parkway
Chardon, OH 44024

EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
----------	--------------

1775

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,054

Applicant(s)

MAZE ET AL.

Examiner

Michael La Villa

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20040226.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20040709.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:
2. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding Claim 7, it is unclear where the claimed alloy flake, having an unspecified amount of Zn as claimed, is supported by the original disclosure. Please see reasons of record in the Office Action mailed on 14 January 2004.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - I. Regarding Claims 1, 2, 4, 6, 7, and 8, it is unclear what is being admitted as the composition of the prior art. Applicant's explanations in the Interview Summary of 9 July 2004 and in the Response do not

comport with the claim language that makes reference to elements in addition to a coating composition comprising liquid medium and particulate metal.

- II. Regarding Claims 1, 2, 4, 6, 7, and 8, it is unclear what is required by the references to "curing" and "cured". Their plain meaning of the language suggests the presence of curing agent in the composition, but applicant has explained that no curing agents are required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
8. A person shall be entitled to a patent unless –
- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
9. (f) he did not himself invent the subject matter sought to be patented.
10. Claims 1 and 5-8 are rejected under 35 U.S.C. 102(a or f) as being anticipated by Applicant's Admissions. Applicant's specification refers to prior art paste composition Eckart STAPA 4ZnAl7 zinc/aluminum alloy paste of the claimed alloy composition and liquid composition. See Specification (Example 1 – page 35).
11. Claims 2 and 3 are rejected under 35 U.S.C. 102(a or f) as being anticipated by Applicant's Admissions. Applicant's specification refers to prior art paste composition Eckart STAPA 4ZnSn30 zinc/tin alloy paste of the claimed alloy

composition and liquid composition. See Specification (Example 2 – pages 37 and 38).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaliardos USP 4,356,036 in view of Applicant's Admissions. Kaliardos teaches a zinc containing flake containing paste, which further comprises non-alloy metallic particulate and other ingredients in order to provide a corrosion resistant metal coating material. See Kaliardos (Abstract; col. 4, line 41 through col. 6, line 44; and col. 7, line 45 through col. 8, line 61). Kaliardos does not exemplify a zinc/aluminum alloy paste as claimed. Kaliardos teaches that zinc containing flake paste in Kaliardos's compositions are effective to confer corrosion resistance. Applicant's Admissions teach a zinc/aluminum alloy flake paste of the claimed composition and structure that has corrosion resistance properties. See Specification (Example 1 – page 35). In view of Kaliardos's teachings and suggestions, it would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate the composition of Kaliardos with any effective

zinc containing flake paste that provides corrosion resistance properties, including the zinc/aluminum alloy flake paste of Applicant's Admissions.

Response to Amendment

- I. In view of applicant's amendments and arguments, applicant has traversed the section 112, first paragraph rejection of the Office Action mailed on 14 January 2004. Except for rejection of Claim 7, rejections are withdrawn. Applicant's alleged support for the claim at pages 7 to 8 specifies the amount of zinc, whereas the claim does not. It is therefore unclear what is applicant's basis for concluding that omission of the amount of zinc is supported by the original disclosure.
- II. In view of applicant's amendments and arguments, applicant has traversed the section 112, second paragraph rejection of the Office Action mailed on 14 January 2004. With respect to points (I)-(III), rejections are withdrawn. Rejection, as pertains to point (IV), is recast above for the reasons given above and in view of applicant's comments summarized in the Interview Summary of 9 July 2004.
- III. Applicant's comments as to the scope of coverage of the claims, both in the Response of 8 April 2004 and in the Interview Summary of 9 July 2004, could not have been predicted from the presented claim language and Specification. Particularly, the argued for complete absence of curing ingredient effectively represents an amendment to the claims. Hence, the claims, in view of applicant's statements as to

their interpretation, have been necessarily reconsidered. Applicant's presented interpretation necessitates the new grounds of rejection set forth above. See MPEP § 706.07(a).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone

Art Unit: 1775

number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
July 9, 2004

A handwritten signature in black ink, appearing to read 'La Villa', with a long horizontal line extending to the right.